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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,784	03/01/2000	RALF DONNER	4797-8PUS	2441

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EXAMINER
RIDLEY, BASIA ANNA

ART UNIT	PAPER NUMBER
1764	

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/486,784	Applicant(s) DONNER ET AL.
	Examiner Basia Ridley FOR	Art Unit 1764

-- The MAILING DATE f this communication appears n the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 March 2000* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *6-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *6-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 March 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Abstract

1. The abstract of the disclosure is objected to because it is longer than one paragraph. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim(s) 6-7 and 12-15 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudymov et al. (DE 35 23 610) in view of Kummel et al. (USP 4,188,915).

Regarding claim(s) 6-7, Gudymov et al. discloses an appliance for gasification of carbon containing fuel comprising:

- a reaction chamber (Fig. 1) having a contour delimited by a cooled reactor wall of the following structure from the outside inward:
- a pressure shell (2, 4, 9);
- a cooling wall (1,3, 5);
- a water cooled cooling gap (12) between the pressure shell (2, 4, 9) and the cooling wall (1,3, 5);
- refractory lining (19); and
- a layer of slag (Abstract).

The reference does not explicitly disclose the cooling wall being protected by a layer of ceramic.

Kummel et al. teaches that it is desired to cover the cooling wall with a protective layer of ceramic to provide radiation protection and, further, to protect the cooling wall and provide rough surface for the slag to adhere if the refractory lining has been lost during operation (C2/L10-37).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cover the cooling wall of the appliance of Gudymov et al. with a ceramic layer, as taught by Kummel et al. for the purpose of provide radiation protection and, further, to protect the cooling wall and provide rough surface for the slag to adhere if the refractory lining has been lost during operation.

Regarding claim 12-15, Gudymov et al. in view of Kummel et al. disclose all of the claim limitations as set forth above. Additionally, Gudymov et al. discloses the appliance wherein:

- the cooling wall has geometric shapes (Fig. 2);
- the cooling wall is one of trapezium-shaped, triangular, rectangular, of undulating form and of smooth form (Fig. 2).

Regarding limitations recited in claims 6-7 and 12-15 which are directed to a manner of operating disclosed appliance, the examiner notes that neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not differentiate apparatus claims from prior art. See MPEP § 2114 and 2115.

4. Claim(s) 8-11 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudymov et al. (DE 35 23 610) in view of Kummel et al. (USP 4,188,915), as applied to claims 6-7 above, and further in view of Price (USP 2,231,295).

Regarding claims 8-9, Gudymov et al. in view of Kummel et al. disclose all of the claim limitations as set forth above. Additionally, Gudymov et al. discloses the cooling wall being pinned and welded in an air tight manner (Abstract) and forming cooling jacket with fins, but the reference does not explicitly disclose the cooling wall comprising half tubes.

Price establishes equivalency of cooling gas passages having various shapes e.g. cooling jackets and half tubes (Fig. 4-5). As instant specification is silent to unexpected results, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the cooling jacket of Gudymov et al. with half pipe passages, since such modification would have involved a mere substitution of known equivalent structures. A substitution of known equivalent structures is generally recognized as being within the level of ordinary skill in the art.

Regarding claim 10-11, the recitation of a method in which said layer of ceramic mass is made, the examiner notes that the determination of patentability is determined by the recited structure of the apparatus and not by a method of making said structure. A claim containing a recitation with respect to the manner in which a claimed apparatus is made does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim.

Regarding limitations recited in claims 8-11 which are directed to a manner of operating disclosed appliance, the examiner notes that neither the manner of operating a disclosed device nor material or article worked upon further limit an apparatus claim. Said limitations do not

differentiate apparatus claims from prior art. See MPEP § 2114 and 2115.

5. Claim(s) 6-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over copending Application No. 09/726,826 in view of Kummel et al. (USP 4,188,915).

Copending Application No. 09/726,826 discloses all of the limitations recited in claims 6-15 of the instant application, but it does not explicitly disclose the cooling wall being protected by a layer of ceramic.

Kummel et al. teaches that it is desired to cover the cooling wall with a protective layer of ceramic to provide radiation protection and, further, to protect the cooling wall and provide rough surface for the slag to adhere if the refractory lining has been lost during operation (C2/L10-37).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cover the cooling wall of the appliance disclosed in the copending Application No. 09/726,826 with a ceramic layer, as taught by Kummel et al. for the purpose of providing radiation protection and, further, to protect the cooling wall and provide rough surface for the slag to adhere if the refractory lining has been lost during operation.

Commonly assigned Application No. 09/726,826, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in

this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

6. Claim(s) 6-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over copending Application No. 09/842,224 in view of Kummel et al. (USP 4,188,915).

Copending Application No. 09/842,224 discloses all of the limitations recited in claims 6-15 of the instant application, but it does not explicitly disclose the cooling wall being protected by a layer of ceramic.

Kummel et al. teaches that it is desired to cover the cooling wall with a protective layer of ceramic to provide radiation protection and, further, to protect the cooling wall and provide rough surface for the slag to adhere if the refractory lining has been lost during operation (C2/L10-37).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cover the cooling wall of the appliance disclosed in the copending Application No. 09/842,224 with a ceramic layer, as taught by Kummel et al. for the purpose of providing radiation protection and, further, to protect the cooling wall and provide rough surface for the slag to adhere if the refractory lining has been lost during operation.

Commonly assigned Application No. 09/842,224, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not

commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claim(s) 6-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim(s) 1-13 of copending Application No. 09/726,826 in view of Kummel et al. (USP 4,188,915).

Claims 1-13 of copending Application No. 09/726,826 recite all of the limitations recited in claims 6-15 of the instant application, but they do not explicitly recite the cooling wall being protected by a layer of ceramic.

Kummel et al. teaches that it is desired to cover the cooling wall with a protective layer of ceramic to provide radiation protection and, further, to protect the cooling wall and provide rough surface for the slag to adhere if the refractory lining has been lost during operation (C2/L10-37).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cover the cooling wall of the appliance recited in claims 1-13 of copending Application No. 09/726,826 with a ceramic layer, as taught by Kummel et al., for the purpose of providing radiation protection and, further, to protect the cooling wall and provide rough surface for the slag to adhere if the refractory lining has been lost during operation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claim(s) 6-15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim(s) 1-12 of copending Application No. 09/842,224 in view of Kummel et al. (USP 4,188,915).

Claims 1-12 of copending Application No. 09/842,224 recite all of the limitations recited in claims 6-15 of the instant application, but they do not explicitly recite the cooling wall being protected by a layer of ceramic.

Kummel et al. teaches that it is desired to cover the cooling wall with a protective layer of ceramic to provide radiation protection and, further, to protect the cooling wall and provide rough surface for the slag to adhere if the refractory lining has been lost during operation (C2/L10-37).

Therefore, it would have been obvious to one having ordinary skill in the art at the time

the invention was made to cover the cooling wall of the appliance recited in claims 1-12 of copending Application No. 09/842,224 with a ceramic layer, as taught by Kummel et al,. for the purpose of providing radiation protection and, further, to protect the cooling wall and provide rough surface for the slag to adhere if the refractory lining has been lost during operation.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

10. In view of the foregoing, none of the claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Basia Ridley, whose telephone number is (703) 305-5418. The examiner can normally be reached on Monday through Thursday, from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola, can be reached on (703) 308-6824.

The fax phone number for Group 1700 is (703) 872-9311 (for Official papers after Final), (703) 872-9310 (for other Official papers) and (703) 305-6078 (for Unofficial papers). When filing a fax in Group 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Basia Ridley
Examiner
Art Unit 1764

BR
June 25, 2003

Glenn Caldarola
Supervisory Patent Examiner
Technology Center 1700